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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,896	01/24/2006	Johannes Jungel-Schmid	45180114PUS1	8291

2292 7590 07/03/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

REHM, ADAM C

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/565,896	JUNGEL-SCHMID ET AL.	
	Examiner	Art Unit	
	Adam C. Rehm	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-19 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/24/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “prism parts in the manner of fresnel screens” per Claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

- the use of “e.g.” or otherwise denoting an example within the claims is improper because it is not clear whether the recited subject matter is claimed subject matter.
 - “the beam axis” in Line 2 lacks antecedent basis.
 - the use of the term “one” in Line 3 is improper because it is not clear as to what element is being referenced.
3. Claim 6 is objected to because of the following informalities:
- “the symmetric lines” in Line 2 lacks antecedent basis.
 - “the wedge angles” in Line 2 lacks antecedent basis.
4. Claim 9 is objected to because of the following informalities:
- “the region” in Line 2 lacks antecedent basis.
5. Claim 15 is objected to because of the following informalities:
- the use of “such as” or otherwise denoting an example within the claims is improper for the aforementioned reason.
 - the use of “or the like”, etcetera, etc., is improper because it renders the claim open-ended and therefore indefinite.
 - “the consecutively arranged refractive prism element” in Line 3 lacks antecedent basis.
6. Claim 17 is objected to because of the following informalities:
- the use of “e.g.” is improper for the aforementioned reason.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-9 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by PALAZZO (US 6,402,344), which discloses a lighting system (see ABSTRACT) comprising:

- A remote controllable light source (120, Column 3, Line 27) having a beam axis (140);
- Drive means (250, 260; Column 3, Line 47-Column 4, Line 34) including a toothed ring for motor/pinion interface (Fig. 2A);
- A housing (110);
- A reflector assembly/housing (402)
- Two aligned refractive/prism elements centered in the housing, along the beam axis (180, 181) and rotatable via the drive means for selective rotation in the same/opposite sense;
- Wherein the refractive elements are at least as large as each other, have equally designed circular cross-sections and with one arranged above the other (Fig. 1);

- Wherein one optical component is arranged between the light and refractive element (upper element 170 is arranged between lower element 170 and light 120, Fig. 1);
- Wherein symmetric lines of wedge angles of the refractive elements are substantially perpendicular to the beam axis (Fig. 1);
- Wherein the motors are arranged in the vicinity of the light source and having shafts to drive the refractive elements (290, 291; Column 4, Lines 14-34);
- Wherein the refractive prism elements are designed with a plurality of prism regions (180, 181); and
- An adapter unit comprising connecting members is mounted to the housing containing the refractive elements (404);

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over PALAZZO (US 6,402,344), which substantially discloses the claimed invention including two refractive/lens elements (180/181), but does not disclose a lens-like depression/bulge. However, more than a mere change of form is necessary for patentability with such a change resulting in more than useful natural phenomenon that

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man has accumulated through common knowledge. *SpanDeck Inc. v. FabCon Inc.*, 215 USPQ 835. Thus, reshaping the existing lens of PALAZZO to manipulate light in order to achieve desired results would have been obvious to one having ordinary skill in the art.

9. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over PALAZZO (US 6,402,344) and OTT (US 6,862,137). PALAZZO substantially discloses the claimed invention, but does not disclose a step motor and control. However, OTT teaches the use of a step motor and control for the purpose of providing precision movement (Column 4, Lines 37-43). It would have been obvious to one of ordinary skill in the art at the time of invention to modify PALAZZO and use the step motor and control as taught by OTT in order to provide increased control of motor movement.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over PALAZZO (US 6,402,344) and BANSBACH ET AL. (US 4,669,034). PALAZZO substantially discloses the claimed invention, but does not disclose a frosted or blackened prism region. However, BANSBACH teaches a blackened prism region parallel to a beam of light to control glare (Column 3, Lines 50-59). It would have been obvious to one of ordinary skill in the art at the time of invention to modify PALAZZO and use the blackened prism regions as taught by BANSBACH in order to control glare.

Allowable Subject Matter

11. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: no prior art of record discloses or otherwise suggests a room lighting system as claimed with emphasis on "prism elements...surrounded by an annular armature, which constitutes a rotor of a respective electromotor...a stator including at least two coils" per Claim 10.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. HAYAKAWA ET AL. (US 6,953,272) discloses a step motor for use with an optical device.

14. MAHANAY ET AL. (US 5,823,661) discloses dual diffusers.

15. SCHWARTZ ET AL. (US 3,668,381) discloses a frosted diffuser.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Rehm whose telephone number is 571.272.8589. The examiner can normally be reached on M-F 9-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571.272.2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ACR
6/13/2006


Thomas M. Sander
Primary Examiner